

**Application number:** 09/923,311**Art Unit:** 1762**Applicant:** Khai Hee Kwan**Examiner:** Alain L Bashore.**Title:** A computer network method for conducting payment over a network by debiting and crediting utilities accounts

such as gas, electricity, water and communication data accounts. We have reproduced our definition at page 2 of our specification : "Utility is defined such as gas, water, electricity or communication data that are essential to most modern home or premises." Also at page 4 under Summary "And in both cases they are merely book entries into the accounts with the utility providers such as gas, water, communication or electricity". There is no evidence to show data accounts must necessarily reveal a mobile telephone voice account.

The examiner has also pointed out the negative limitation found in Claim 1 is new matter ( ibid at page 4) under First Paragraph of 35 USC 112 . The examiner also stated that a negative limitation in the claims requires a showing in the specification as to the exact disclosure. A reading of the specification in totality is not sufficient. ( See page 6)

We have cancelled this negative limitation for this RCE. However, it should be noted that we do not agree with this assertion. Firstly, under First Paragraph of 35 USC 112, New Matter could only be raised when the negativity actually "introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112. In re Anderson, 471 F. 2d 1237, 176 USPQ 331 (CCPA 1973)." The examiner did not provide any evidence of "new concepts" and had simply concluded that the negative limitation was not originally disclosed. While it might be added that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded, in the instance case here utilities are defined in the specification and further limit them to "essential to most modern home or premises". Therefore, taking the examiner's previous suggestion, a road toll could not be an essential utility to the modern home.

Although unstated, we presumed the examiner also relied on a literal finding of the negative limitation in the disclosure for such negative limitation to survive para 1 of 35

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USC 112. A lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). As noted by the examiner there is actual antecedent in the specification reading in totality to support the negative limitation and therefore could not have violated the description requirement. ( See page 6)

The examiner also contented that because the negative limitations were not found, they were not examined ( at page 4). Again there is no legal precedent for such contention. All of these limitations of the claims must be considered regardless of whether or not they were supported by the specification as filed. In *re Wilson*, 57 CCPA 1029, 424 F. 2d 1382, 165 USPQ 494 (1970); In *re Miller*, 58 CCPA 1182, 441 F. 2d 689, 169 USPQ 597 (1971).

#### REMARKS FOR CURRENT AMENDMENTS FOR RCE.

While all the claims are NEW, they are actually amended/arrangement from those found in the final rejection. In particular, the main representative claim 31 is actually claim 1 previously except it now specifically claiming type of utility services as well as a negative element of not using a credit card. Antecedent for non credit card usage is found in our specification at page 3 and 4 under the heading "Background to the Invention" (at last paragraph) and we quote " Prior to the present invention, cellular phones and/or other wireless communication devices have been used in a variety of different procedures involving the transfer of funds between different accounts involving financial institutions and different financial related accounts. These procedures leave something to be desired in that they are unduly complicated and less convenient and/or less secure and costly. Furthermore, some qualification may be required as in a credit card where users must attain certain financial standing to gain access to this facility. In short, this invention is to

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provide an alternative non-banking solution to making micro payment on the Internet and to increase stakeholders in the e-commerce world by making the process of paying and receiving funds universally available and at a minimum cost."

It is quite obvious to one skilled in the art that the applicant is contemplating on solving payment problem without using banking solutions and credit card is one of this method. Therefore the explicit exclusion of credit card will not raise new matter by implication of including any new matters not found in the specification. If there is, then we respectfully ask the examiner to provide an example of 'new matters' violating Para 1 of 35 USC 112 that could be equivalent to apply for making payment that is known at the time of this invention.

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